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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/989,414	11/21/2001	Sang On Park	3449-0179P	9772
2292	7590	09/25/2006	EXAMINER	
BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747			AGUSTIN, PETER VINCENT	
			ART UNIT	PAPER NUMBER
			2627	

DATE MAILED: 09/25/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.		Applicant(s)	
	09/989,414		PARK, SANG ON	
	Examiner		Art Unit	
	P. Agustin		2627	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 7/18/05, 2/21/06 & 7/07/06.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 and 5-11 is/are pending in the application.
- 4a) Of the above claim(s) 10 and 11 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 5-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-3 and 5-11 are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|-----------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-3 & 5-11 are now pending.

Continued Examination Under 37 CFR 1.114

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on February 21, 2006 has been entered.

Election/Restrictions

3. Applicant's election with traverse of Group I, Species (a), claims 1-3 & 5-9 in the reply filed on July 7, 2006 is acknowledged. The traversal is on the following grounds, which are not found persuasive:

(a) In response to Applicant's arguments on page 2, second to the last paragraph that the previous Office Action does not address the issue of whether there is no serious burden on the Examiner and is improper at least for that reason, the Examiner disagrees. Item 5 of the Office Action explained how the inventions are distinct, and item 6 explained that each invention would require a different field of search.

(b) In response to Applicant's arguments on page 2, last paragraph thru page 3, first paragraph that "because the Examiner has completely addressed the features found in currently pending claim 11 in a previous Office Action on the merits, the Examiner has not demonstrated that the search and examination of the entire application cannot be made without serious burden, especially where the Examiner has fully examined this

claimed subject matter on the merits”, the Examiner disagrees. The Examiner recognizes, prior to the first Office Action on the merits, that if the search and examination of all the claims in an application can be made without serious burden, the examiner must examine them on the merits, even though they include claims to independent or distinct inventions (MPEP § 803). However, the Applicant is directed to 37 C.F.R. § 1.142, which authorizes the Examiner to require a restriction at any time before final action. If at any time before prosecution closes, the Examiner determines that there is serious burden for examination, the Examiner may require a restriction.

(c) In response to Applicant’s arguments on page 3, paragraph 2 that “it is fundamentally unfair to require Applicants to file yet another Application to have the same subject matter that was already claimed and examined...”, the Applicant has not provided legal basis or authority regarding this argument.

(d) In response to Applicant’s arguments on page 3, paragraph 3 that “this [sic] violates Applicant’s fundamental substantive and procedural due process rights under the Administrative Procedures Act”, the Examiner disagrees for the same reasons noted in items (b) and (c) above.

(e) In response to Applicant’s arguments on page 3, last paragraph thru page 4, first paragraph that “the Office Action fails to provide any objective factual evidence that the two species are independent, i.e., it fails to demonstrate, or even allege, that these two species are disclosed without any relationship therebetween, or if there is a disclosed relationship therebetween, provide a discussion of why the disclosed relationship does not prevent restriction, as required by MPEP § 808.01(a). Nor does the Office Action

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provide any reasons why these two species are distinct”, the Examiner disagrees. The Applicant is directed to page 3, paragraph 6, which explains that the species are independent or distinct because they present mutually exclusive embodiments of tilt control.

(f) In response to Applicant’s arguments on page 4, second paragraph that “this election of species requirement is improper because the Examiner has already examined claims directed to both species and has provided no evidence that a serious administrative burden exists to continue to examine that subject matter in the pending Continued Examination of this Application”, the Examiner disagrees for the same reasons noted in items (b) & (e) above.

The requirement is still deemed proper and is therefore made FINAL.

4. Claims 10 & 11 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention/species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on July 7, 2006.

Specification

5. The disclosure is objected to because of the following informalities:

Page 7, line 8: “a RE signal” should be --an RF signal--.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

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7. Claims 1-3 & 5-9 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

In regard to claim 1, there is no disclosure on how to detect a “track” of a focus error “for maximizing an RF signal or minimizing jitter”. The specification describes on page 8, lines 8-14 that “the track center of an FE signal per one disk rotation at a point where a RF signal is the maximum or the track center of a FE signal at a point where the jitter per one disk rotation is the minimum is set as a tilt control reference”. (It is also noted that in the reply filed on July 18, 2005, the Applicant submitted that “detecting a track of a focus error” simply means “tracking a focus error”.) However, even in light of this disclosure, it is not described how one of ordinary skill in the art would be enabled to track a focus error for maximizing an RF signal or minimizing jitter. Furthermore, it should be noted that the claimed detection “for maximizing an RF signal or minimizing jitter” is not the same as the disclosed “where a RF signal is the maximum” or “where jitter is minimum”.

Furthermore, in regard to claim 1, there is no disclosure on how to calculate “a variation per track of the focus error by using the maximum and minimum values of the focus error”. The specification describes on page 13, lines 7-12 that “a spindle motor for rotating the optical disk is operated to detect FE DC variation per one rotation as variation per track...”; however, it is not sufficiently disclosed how a spindle motor would be operated by one of ordinary skill in the art in order to calculate a “variation per track” of a focus error.

In regard to claim 2, as noted above, there is no disclosure on how to calculate a “variation per track”; therefore, it follows that there is no disclosure on how to calculate “a variation per track of the maximum value and the minimum value of the focus error to detect a normalized DC component”.

In regard to claim 3, as noted above, there is no disclosure on how to calculate a “variation per track”; therefore, it follows that there is no disclosure on how to vary a tilt reference as much as the variation per track to control the tilt, as claimed.

In regard to claim 5, as noted above, there is no disclosure on how to calculate a “variation per track”; therefore, it follows that there is no disclosure on how to normalize the variation per track and the surface vibration to control the tilt.

Claims 2, 3 & 5-9 are dependent upon claim 1.

8. In light of the rejection under 35 U.S.C. § 112-1st paragraph above, no art rejections or indications of patentability are made at this time.

Response to Arguments

9. Applicant’s arguments filed on July 18, 2005 have been fully considered but they are not persuasive.

a. In regard to the rejection of the claims under 35 U.S.C. § 112-1st paragraph as failing to comply with the enablement requirement, the Applicant argues (see pages 11-17) that the rejection fails to make out a prima facie case of lack of enablement because the “Wands” factors have not been addressed, and therefore the Examiner has not established a reasonable basis to question the enablement. The Examiner disagrees. See MPEP § 2164.04, which states that “while the analysis and conclusion of a lack of

enablement are based on the factors discussed in MPEP § 2164.01(a) and the evidence as a whole, it is not necessary to discuss each factor in the written enablement rejection". In this case, since the Applicant has not provided enough information on how to make and use the claimed invention, it should have been clear to the Applicant that there is doubt regarding quantity of experimentation, unpredictability in the art, etc., even though the Examiner did not discuss each factor in the Office Action.

10. Applicant's arguments filed on February 21, 2006, with respect to the rejection of the claims under 35 U.S.C. § 103(a) are now moot because the art rejections have been withdrawn.

Conclusion

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to P. Agustin whose telephone number is 571-272-7567. The examiner can normally be reached on Monday-Friday 9:30-5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, A. L. Wellington can be reached on 571-272-4483. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

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For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

P. Agustin
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A handwritten signature in black ink, appearing to read "B. E. Miller", with a stylized flourish at the end.

Brian E. Miller
Primary Examiner
Art Unit 2627